

## REMARKS

Reconsideration of the Office action mailed August 24, 2004 is requested in view of the foregoing amendments and the following remarks. Prior to the entry of this Amendment, claims 1-18 were pending. In the Office action, the Examiner stated that claims 1-6 were not patentable over Bynon under 102(e) and/or 103(a); claims 8-13 and 15-17 were not patentable over Golds (alone or in combination with Chouinard or Cook) under 102(e) and/or 103(a); and claim 18 was not patentable over Ruiz under 102(e). The Office action provided no specific analysis of the patentability of claims 7 and 14 and Applicant requests clarification.

The Examiner stated that claim 17 lacked antecedent basis for "the radiopaque portion of the inner or outer layer." Applicant responds that "the radiopaque portion of the inner or outer layer" refers to the limitation recited in claim 16, from which claim 17 depends, of "a radiopaque portion" with which "at least one of the inner and outer layers are provided." Applicant believes the antecedent basis is proper, but will amend the claim if the Examiner suggests alternate language.

Applicant has amended claim 16 to correct a typographical error. No change to the scope of the claim has been effected by this amendment.

Applicant believes the invention as recited in claims 8-17 to be patentable over Golds, whether alone or in combination with other references. However, because Applicant completed the invention of claims 8-17 prior to the earliest priority date of Golds, the Golds reference is not prior art for the purposes of this application. Golds apparently was filed on November 19, 2003, claiming priority to a non-provisional

application apparently filed on May 16, 2000 and a provisional application apparently filed on May 20, 1999.

Applicant submits with this amendment a declaration under 37 CFR §1.131 by inventor Dr. Richard R. Heuser, with supporting exhibit, establishing that the invention recited in claims 8-17 16 was completed in this country before May 20, 1999, and thus Golds is not prior art under §102. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejections of claims 8-17.

The Examiner stated with respect to claim 18 that the “intended use recitation/functional language of the claim carries no patentable weight in the absence of any distinguishing structure.” The Examiner did not identify what she considered to be functional language in the claim and Applicant requests clarification. In any case, the claim recites distinguishing structure that defines the invention over the prior art. Specifically, claim 18 recites that the wire structure adjacent the distal end is more compliant and expands more rapidly as compared to the wire structure of the middle portion of the mesh layer. Such limitation is the generic structure of any of the constructions described in the specification at pp. 13-14 and Figs. 13a, 13b, and 13c, or equivalent constructions.

The Examiner cited Figs 5c and 6 in Ruiz as anticipatory, but Ruiz does not teach or suggest the claimed structure. Ruiz instead teaches away from such structure, because Ruiz discloses a stent in Figs 5c and 6 that expands at its **proximal** end more readily than the middle portion or the distal end (see also Figs. 7b and 7c of Ruiz). The claimed structure of a more compliant **distal** end solves the problem of downstream flow of

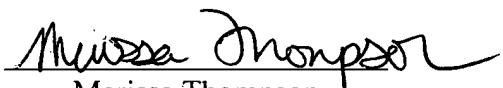
dislodged debris. This problem is not even recognized by Ruiz, so it would not be obvious to modify the structure of Ruiz to provide the claimed structure. Therefore, Applicant requests reconsideration and allowance of claim 18.

The above amendment also amends the specification to claim priority based on the parent application.

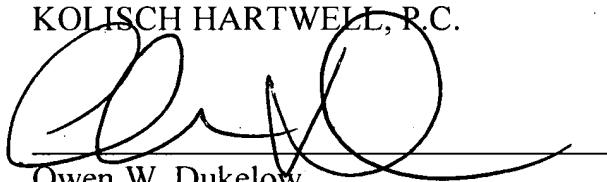
If there are any questions or remaining issues, the Examiner is urged to contact the undersigned attorney by telephone.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on February 24, 2005.

  
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Respectfully submitted,  
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